

REMARKS/ARGUMENTS**The Office Action**

In the above-mentioned non-final Office Action, claims 181-244 were rejected as being anticipated by U.S. Patent 6,380,132 (Mihara) and claims 187 and 207 were rejected as being indefinite.

In response thereto, claims 223-264 are added. Claims 201-205, 207-214, 216, 217, 221 and 222 have been amended to correct clerical errors in dependency.

Interview Summary

The below-signed counsel for Applicant and Applicant's technical representative, Dr. Ronald Ugolick, thank Examiner Ahmad for the courtesies extended to them during their personal interview on May 10, 2006. During that interview, the "adapted to cause" language was discussed. The examiner stated that it was the policy of the PTO to never accord any patentable weight to such language. Counsel responded that this was contrary to MPEP 2173.05(g), *In re Barr*, *In re Venezia*, and the (non-precedential) Board decision in *Ex parte Prall*, Appeal No. 2003-1556. Counsel pointed out how *In re Hutchison*, which the examiner cited in this office action, was not relevant. Counsel and Dr. Ugolick pointed out that the subject claim was not similar to the following hypothetical claim: "A sheet structure adapted for use in a business transaction, comprising: _____", which would be an intended use phrase which is not entitled to patentable significance.

Counsel requested that the Examiner send him copies of the PTO memorandum setting forth such policy, which the Examiner has not done. Following the interview, counsel did a quick search in the PTO database for patent issuing recently where the Examiner or the SPE were the primary examiners and which used "adapted to" or similar language in the body of the claims. Numerous patents were generated in the search.

Discussion

I. The rejections of the claims as being anticipated by Mihara is respectfully traversed.

In his rejection the Examiner stated that an "adapted to" phrase is not given any patentable weight in a prior art rejection because "said phrase is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense." This is an incorrect *per se* statement is an incorrect statement of the law, Applicants respectfully contend.

In support of this statement, the Examiner cited without any discussion the case of *In re Hutchinson*, 69 USPQ 138. This is a 1946 decision of the Court of Customs and Patent Appeals. It is nowhere cited in the MPEP, because the decision is limited to its specific facts. Specifically, it held that a statement in the preamble that the laminated article was adapted for use in making a template or the like did not constitute a patentable limitation. It was a ruling on a specific "adapted for" phrase in a preamble. It did not hold that all "adapted for" phrases in preambles are not patentable limitations.

MPEP 2173.05(g) states that "[t]here is nothing inherently wrong with defining some part of an invention in functional terms." It goes on to cite *In re Barr*, 170 USPQ 33 (CCPA) and *In re Venezia*, 189 USPQ 149 (CCPA 1976), which used the claim language "incapable of forming ..." and "adapted to be positioned ...", respectively, and which found that this was acceptable claim language which imparted patentable significance to the respective claims.

The Examiner further stated at the top of page 4 of his Office Action: "The intended use phrases such as 'can be bent', 'when separated', etc. have not been given patentable weight because said phrases are deemed to be of positive limitations."

1. The law is not that terms in a claim which recite an intended use cannot be used to distinguish a claimed article over a prior art article. If the Examiner disagrees, he is respectfully requested in his next action to point out support in the MPEP or case law for his position.

2. The Examiner has not specifically identified which phrases he considers to be the "intended use" phrases. If he repeats this rejection, he is respectfully requested to identify each of these phrases, noting their starting and ending words.

3. If the Examiner repeats this "intended use" rejection, he is respectfully requested to provide the basis for this finding.

4. The phrases (presumably) at issue are "the . . . sheet and the . . . cut line being constructed and adapted to cause the sheet structure . . . to split on . . . the cut line when the sheet structure . . . is bent on the . . . cut line upwardly only once or downwardly only once" (see independent claim 181), and similar phrases in the other independent claims. These are structural limitation phrases entitled to a full patentable significance.

5. These phrases result in structural differences between the claimed invention and the prior art which patentably distinguish the claimed invention over the prior art.

6. In particular, Mihara does not have these structural limitations, expressly or inherently. The release backing 5 supports the labels (col. 2, lines 5-10 and FIG. 10 at 9). The materials mentioned for the release backing, namely, polyester, PET and paper materials (col. 6, lines 11-27) would not split with a single fold as required in the claims. One would not want the release backing to split or break when the sheet is folded because if it did break it would make it very difficult, if not impossible, to remove the liner from the label.

7. If the Examiner is contending that the Mihara release layer 5 can be split with a single fold, then he is requested to so state, fully explain and provide support for this contention in his next action.

II. The rejections of claims 187 and 207 as being indefinite are respectfully traversed. Claim 181 does not recite that "the four cut lines intersect to form the sheet portions."

Concluding Remarks

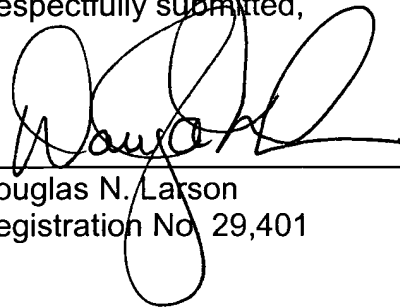
Accordingly, it is respectfully contended that all of the claims now pending are in condition for allowance. Issuance of the Notice of Allowance at an early date is thus in order.

If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel for Applicant at (310) 785-5384 to seek to resolve them.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 10-0440. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Dated: July 10, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Douglas N. Larson', is written over a horizontal line.

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